

Atty. Docket No. JP920000032US1
(590.050)

REMARKS

In the Office Action dated February 27, 2007, Claims 1-4, 6 and 7 were pending. All of these claims are independent claims and stand finally rejected under 35 U.S.C. § 103(a) over Park.

Applicant and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner. On June 27, 2007, Applicant's representative conducted a telephone interview with the Examiner in which the pending claims and the Park reference were discussed. While no agreement was reached with respect to the claims; however, the Examiner indicated that the amendments presented herein appeared to overcome the applied art as discussed below. It was agreed the these amendments would be submitted along with a Request for Continuing Examination and the Examiner would conduct a further art search. The courtesy of a further telephone interview is requested prior to the issuance of a further Office Action should the claims as amended herein not be immediately allowable.

Applicant has therefore amended independent Claims 1-4, 6 and 7 and filed herewith a Request for Continued Examination. It should be noted, however, the amendments made herein are not in acquiescence of the Office's position on allowability of the claims, but merely to expedite prosecution, and that Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

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Rejections under 35 U.S.C. § 103(a):

Claims 1-4, 6 and 7 stand rejected as being unpatentable over U.S. Patent 6,260,141 to Park (hereinafter "Park") under 35 U.S.C. § 103.

Applicant respectfully submits that in order to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify a reference or combine reference teachings, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Second, the modification or combination must have some reasonable expectation of success. Third, the prior reference or combined references must teach or suggest all the claim limitations. MPEP § 2143.

The Remarks submitted by Applicant on January 10, 2007 in response to the Office Action dated October 10, 2006 are equally applicable here. However, in order to expedite prosecution, Applicant submits the following in addition to those remarks.

As best understood, Park discloses a software licensing system that allows users to download and use software programs from servers "open to all software manufacturers." (Park, Abstract). Each user (or computer) is assigned a license by a software registration server. (*Id* at Col. 3, lines 55-57). When a user needs a refreshed license (e.g. due to time-expiration or attempting to update a program), the registration server utilizes a user public key and a secret key in a user-ID file to generate a new license file, which is then transmitted to the user. (*Id* at Col. 3, lines 47-64).

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At best, Park only teaches secure licensing, via the creation of a license file by a software registration server, of software from any software manufacturer in the world. (*Id* at Col. 3 line 11-13). The teachings of Park are not sufficient to render the subject matter of invention, as claimed, obvious since Park's software licensing system is not limited to connection-fee based customer access. Rather, the server in Park is accessible by any user (irregardless of their connection service), so long as the user purchases a license to the software. (*Id* at Col. 3 lines 31-46).

Such unconstrained software licensing stands in stark contrast to Applicant's claimed invention, wherein *only connection fee customers have free access to the provider's* downloadable software (i.e. "enclosure"). (Specification, page 17, line 2-page 3, line 3). Thus, the instantly claimed invention provides a method and system for the tying of *free software downloads from an internet service provider to that provider's connection fee-paying customers*, only during the time in which the customer subscribes to the provider. (*Id* at page 2, line 17-page 11, line 8). Should the user end its connection agreement with the provider, the present invention also provides a method for ensuring that the continued use of the software by the user is no longer possible. *Id*. Furthermore, the presently claimed invention provides for updating the licensing information, etc., upon establishing a connection of the user and the provider, *thus evidencing maintenance of the fee agreement*. (*Id* at page 3, lines 8-10).

Accordingly, Claim 1 has been rewritten to recite, *inter alia*, "updating said information with which a license key can be generated by effecting a connection with said network provider, wherein said updating comprises...transmitting a new license

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key ... wherein said transmitting of said information for generating said new license key is conditioned upon said user establishing maintenance of said condition of payment of said connection fee via said connection" (Claim 1, emphasis added). This amendment is intended to clarify that the maintained connectivity establishes fee-paying customer status and thereby allows access to free software and license key (information) updates. Therefore, it is respectfully submitted that Park falls short of the claimed invention, and reconsideration and withdrawal of the outstanding rejections is respectfully requested.

For the foregoing reasons, Applicant respectfully submits that claims 1-4, 6 and 7 are allowable over Park. Applicant respectfully requests that the Examiner withdraw the rejection of claims 1-4, 6 and 7 as being unpatentable over Park under 35 U.S.C. § 103(a). Further, it is respectfully submitted that independent claims 1-4, 6 and 7 fully distinguish over the applied art and are thus in condition for allowance.

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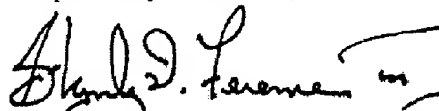
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In summary, it is respectfully submitted that the instant application, including claims 1-4, 6 and 7, is presently in condition for allowance. Notice to the effect is hereby earnestly solicited. As discussed above, if there are any further issues in this application, the courtesy of a telephone interview is requested prior to the issuance of a further Office Action in this case.

Respectfully submitted,



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